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Qualcomm Incorporated
Patents Department
5775 Morehouse Drive
San Diego, CA 92121-1714

EXAMINER

MOORE, JAMES K

ART UNIT PAPER NUMBER

2686

DATE MAILED: 06/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/074,140

Applicant(s)

GOLDSMITH ET AL.

Examiner

James K Moore

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– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 7-11 is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-8 and 10-14 is/are rejected.
- 7) ☒ Claim(s) 4 and 9 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed March 22, 2004 with respect to claims 1-6 and 12-14 have been fully considered but they are not persuasive.

Regarding claims 1 and 12, the applicant argues that Duske teaches an auto-fill system that is dependent on information provided in the incoming message, not on the type of formatted message received. See page 6 of the amendment. However, claims 1 and 12 refer to "a number of pre-defined formatted messages," not "message types." The Duske receiver is capable of receiving a number of pre-defined formatted messages which may have different reply aliases. Therefore, the information copied from a formatted message to a response message (the reply alias) depends on which formatted message was received. See Duske, col. 29, lines 1-25.

2. Applicant's arguments with respect to claims 7, 8, 10, 11 and 15 have been considered but are moot in view of the new ground(s) of rejection.

Double Patenting

3. Applicant is advised that should claim 11 be found allowable, claim 15 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing

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one claim to object to the other as being a substantial duplicate of the allowed claim.

See MPEP § 706.03(k).

Claim Rejections - 35 USC § 102

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 1, 5, 6 and 12-14 are rejected under 35 U.S.C. 102(a) as being anticipated by Duske, Jr. et al. (U.S. Patent No. 6,292,473).

Regarding claim 1, Duske discloses a communication terminal (AMC 18) comprising a receiver (DCE 34) for receiving a formatted message (a proforma message) out of a number of pre-defined formatted messages. The formatted message comprises a message identification code (a form identifier) and a plurality of information fields. See col. 4, lines 14-30; col. 4, line 66 through col. 5, line 16; and col. 5, lines 27-45. The communication terminal also comprises an output device (display 56) for presenting the formatted message to a user of the communication terminal, an input device (keyboard 42) for responding to the formatted message, and a memory (48) for storing the formatted message and for storing field-mapping information (part of the software code). The field-mapping information indicates information (a reply alias or a source alias) to be copied from the formatted message to a response message based on which of the pre-defined formatted messages was received (e.g., the reply alias from a first message and a second message may be different). See col. 5, line 63 through

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col. 6, line 14; col. 7, lines 3-15; col. 28, line 64 through col. 29, line 25. The communication terminal also comprises a processor for creating the response message in response to an indication from the input device of a request to respond to the formatted message. The response message comprises a response message information field (destination address alias), and information from one of the information fields of the formatted message (reply alias) is copied into the response message information field based on the field-mapping information. The communication terminal also comprises a transmitter (DCE 34) for transmitting the information relating to the response message. See col. 5, lines 27-45 and col. 28, line 64 through col. 29, line 25.

Regarding claim 5, Duske discloses all of the limitations of claim 1, and also discloses that the information from the information fields of the formatted message is alterable by a user of the communication terminal after it is copied into the response information field. See col. 29, lines 36-54.

Regarding claim 6, Duske discloses all of the limitations of claim 1, and also discloses that the formatted message comprises two or more sub-messages (each field is a sub-message), and that the response message corresponds to a selected sub-message. See col. 4, line 66 through col. 5, line 16, and col. 28, line 64 through col. 29, line 25.

Regarding claim 12, Duske discloses a method for automatically entering information into formatted messages in a communication terminal. The method comprises selecting a formatted message (a proforma message) to respond to out of a number of pre-defined formatted messages, determining a message identification code

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of the formatted message (a form identifier); identifying an information field (reply alias or source message) of the formatted message to be copied into a response message based on field-mapping information (part of the software code) stored in a memory (48). The field-mapping information indicates information (a reply alias or a source alias) to be copied from the formatted message to a response message based on which of the pre-defined formatted messages was received (e.g., the reply alias from a first message and a second message may be different). See col. 5, line 63 through col. 6, line 14; col. 7, lines 3-15; col. 28, line 64 through col. 29, line 25. The method also comprises creating the response message. The response message comprises response message information fields, and one of the response message information fields (destination address alias) is filled in with information from one of the information fields (reply alias or source message) of the formatted message based on the field-mapping information. See col. 4, line 66 through col. 5, line 16; col. 7, lines 3-15; and col. 28, line 64 through col. 29, line 25.

Regarding claim 13, Duske discloses all of the limitations of claim 12, and it is inherent that the method comprises presenting the response message to a user of the communication terminal and receiving information from the user in a response message information field (e.g., the body of the reply message) which has not been filled in.

Regarding claim 14, Duske discloses all of the limitations of claim 13, and also discloses that the response message information field is alterable by a user. See col. 29, lines 36-54.

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6. Claims 7, 8, 10, 11, and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Gitlin et al. (U.S. Patent No. 5,630,207).

Regarding claim 7, Gitlin discloses a signal-bearing medium (memory 318) tangibly embodying a program of machine-readable instructions executable by a digital processing apparatus (processor 310) to perform operations for automatically entering information into formatted messages in a communication terminal (pager device 110). See Figure 3 and col. 3, lines 7-40. The operations comprise receiving a formatted message. The formatted message may comprise a message identification code (message identifier) and a plurality of information fields (reply components). The operations also comprise presenting the formatted message to a user of the communication terminal. See col. 6, lines 40-67. The operations also comprise receiving an indication to send a response message to the formatted message. See col. 7, lines 1-8. The operations also inherently comprise determining a message identification code of the formatted message to which the response message corresponds and identifying which information fields to be copied into the response message based on the message identification code. The operations also comprise creating the response message using the identified information fields, and transmitting the response message. See col. 7, lines 1-41.

Regarding claim 8, Gitlin discloses all of the limitations of claim 7, and also discloses that the medium comprises operations of creating the response message using the identified information fields and input from the user. See col. 7, lines 1-7.

Regarding claim 10, Gitlin discloses all of the limitations of claim 7, and it is inherent that the information from one of the information fields may be alterable by a user (e.g., if a user changes his mind and selects another reply code) after it is copied into the response information field.

Regarding claims 11 and 15, Gitlin discloses all of the limitations of claim 7, and also discloses that the formatted message comprises two or more sub-messages (e.g., reply codes "dinner", "ballgame", and "theatre"), and that the response message corresponds to a selected sub-message. See Figure 4.

Claim Rejections - 35 USC § 103

7. Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Duske, Jr. et al. in view of Averbuch et al. (U.S. Patent No. 5,896,566).

Regarding claims 2 and 3, Duske discloses all of the limitations of claim 1, but does not disclose that the field-mapping information is configurable by a remote entity or transmitted to the communication terminal from a remote location.

Averbuch discloses a system and method for updating the software on a mobile communication terminal. Updated software is configured by a remote entity and transmitted to the mobile communication terminal from a remote location. Among the advantages of this invention is allowing the software on the mobile communication terminal to be updated without the inconvenience of bringing the mobile communication terminal to a service shop. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Duske with Averbuch, such that the operating

software of the communication terminal, which includes the field-mapping information, is configured by a remote entity and transmitted to the communication terminal from a remote location, in order to avoid the inconvenience of bring the communication terminal to a service shop to update its software.

Allowable Subject Matter

8. Claims 4 and 9 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ken Moore, whose telephone number is (703) 308-6042. The examiner can normally be reached on Monday-Friday from 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks-Harold, can be reached at (703) 305-4379.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 872-9314 (for Technology Center 2600 only)


Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.

Ken Moore

5/27/04

JKM


CHARLES APPIAH
PRIMARY EXAMINER